

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-5, 7, 8, 10, 11, and 15-34 are pending in the present application, Claims 1-5 and 7-11 having been amended, Claims 33 and 34 having been added, Claims 15-32 having been withdrawn as directed toward a non-elected invention, and Claims 6, 9, 12, and 13 having been canceled without prejudice or disclaimer. Support for the amendments to Claims 1 and 2 is found, for example, in original Claim 6. New Claims 33 and 34 correspond to Claims 1 and 14, but do not include the means-plus-function language. The amendments to Claims 3-5 and 7-11 are believed to be self-evident from the originally filed disclosure. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 5, 8, and 10 were objected to for being improper multiple dependent claims; Claim 14 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement; Claims 1-3, 6, 7, and 11-13 were rejected under 35 U.S.C. §102(e) as anticipated by Mancuso (U.S. Patent No. 6,108,455); Claim 4 was rejected under 35 U.S.C. §103(a) as unpatentable over Mancuso in view of Qian et al. (U.S. Patent No. 6,108,455, hereinafter Qian); Claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over Chaddha (U.S. Patent No. 6,360,019); and Claim 14 was indicated as being allowable if the rejection under 35 U.S.C. §112, first paragraph, is overcome.

With respect to the objection to Claims 5, 8, and 10, these Claims are amended to remove the improper multiple dependencies. Accordingly, Applicants respectfully request that Claims 5, 8, and 10 be examined on the merits.

With respect to the rejection of Claim 14 under 35 U.S.C. §112, first paragraph, Applicants respectfully traverse this ground of rejection. It is respectfully submitted that no *prima facie* case has been established and that this rejection must, therefore, be withdrawn.

The outstanding Office Action merely offers the completely unexplained **conclusion** that "The information contained in the disclosure of the application is insufficient to inform one skilled in the art to know how to both make and use the claimed invention." It is noted that MPEP §2164.01 requires far more than a mere assertion of inadequacy. The outstanding Office Action fails to establish any reasonable basis to doubt that the artisan could practice the claimed invention in its entirety. Applicants note that MPEP §2164.04 states "...the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention."

In this regard, MPEP §2164.01 further states that:

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. These factual considerations are discussed more fully in MPEP § 2164.08 (scope or breadth of the claims), § 2164.05(a) (nature of the invention and state of the prior art), § 2164.05(b) (level of one of ordinary skill), § 2164.03 (level of predictability in the art and amount of direction provided by the inventor), § 2164.02 (the existence of working examples) and § 2164.06 (quantity of experimentation needed to make or use the invention based on the content of the disclosure).

As stated by the court in *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971), "it is incumbent upon the Patent Office, whenever a rejection [for lack of enablement] is made, to explain *why* it doubts the truth or accuracy of any statement in a

supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.”

MPEP § 2164.04 instructs that in order to make a valid *prima facie* case of lack of enablement, the following must be shown:

While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written enablement rejection. The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See MPEP 2164.06(a). References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required.

Consequently, it is respectfully submitted that the present rejection of Claim 14 under the enablement requirement of the first paragraph of 35 U.S.C. §112 has not been presented in a manner to establish a *prima facie* case that can be said to comply with the requirements of the MPEP and case law cited therein. Thus, it is further respectfully submitted that that this rejection must, therefore, also be withdrawn.

Claim 34 is similar to Claim 14, and should be allowable for at least the same reasons as Claim 14.

Furthermore, it is believed that those skilled in the art reading page 21, lines 10-26 of the specification, for example, would be able to make and use the present invention.

With respect to the rejection of Claim 6, the subject matter of which is included in amended Claim 1, as anticipated by Mancuso, Applicants respectfully traverse this ground of rejection. Amended Claim 1 recites, *inter alia*, “decision means for deciding a similarity between a first pixel and a second pixel of an image based on a plurality of images obtained by photographing an identical subject at different times.” Mancuso does not disclose or suggest this element of Claim 1.

Mancuso describes a system and method for reducing noise using recursive noise level estimation. The system and method for noise reduction substitute a target pixel with a weighted average of a plurality of neighboring pixels according to the degree of similarity between the target pixel and the neighboring pixels.¹ The only embodiments described in Mancuso rely on pixels of the same image that are in a previous scan line or pixels of the same image that are in the same scan line as the target pixel to determine a degree of similarity.² There is no disclosure or suggestion of deciding a similarity between a first pixel and second pixel of an image based on a plurality of images obtained by photographing an identical subject at different times.

When rejecting Claim 6, the outstanding Office Action refers to col. 2, line 45 of Mancuso, which merely mentions “video signals” and “video sequences.” However, Mancuso does not disclose or suggest that the “video signals” or “video sequences” have anything to do with determining a similarity between two pixels. Specifically, the “video signals” and “video sequences” are not described in Mancuso as having anything to do with differencer 204 and similarity evaluation block 214.

The PTO must consider the invention as a whole, and cannot break it down to its components and rebuild the invention using the present claims as a guide. To the extent that the outstanding Office Action is relying on the separate elements (i.e., similarity evaluation

¹ Mancuso, abstract.

² Mancuso, col. 3, lines 17-39 and col. 4, lines 46-59.

block 214, differencer 204, and the mention of “video signals” and “video sequencing”) of Mancuso being combined together to some how function as the claimed “decision means...,” this rationale is inadequate to support the 102 anticipation rejection. There is no teaching or suggestion by Mancuso that these separately disclosed elements should be combined to function as the claimed invention. It is well established that establishing anticipation requires the citation of a single prior art reference that discloses each and every element arranged together exactly as in the claimed arrangement. *See In re Arkley*, 172 USPQ 524, 526 (CCPA 1972) (Thus, for the instant [35 U.S.C. §102] rejection . . . to have been proper, the . . . reference must clearly and unequivocally disclose the claimed [subject matter] or direct those skilled in the art to the [claimed subject matter] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.”). Since the outstanding Office Action attempts to improperly pick and chose elements of Mancuso to reconstruct the claimed invention, Applicants respectfully submit that a proper anticipation rejection has not been established.

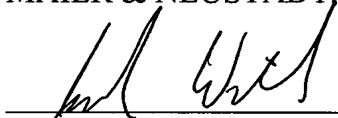
In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and any claims dependent thereon) patentably distinguish over Mancuso. Claims 2 and 33 recite elements similar to those of Claim 1. Thus, Applicants respectfully submit that Claims 2 and 33 (and any claims dependent thereon) patentably distinguish over Mancuso, for at least the reasons stated for Claim 1.

Addressing each of the further rejections, each of the further rejections is also traversed by the present response as no teachings in any of the further cited references to Qian and Chaddha can overcome the above-noted deficiencies of Mancuso. Accordingly, it is respectfully requested that those rejections be withdrawn for similar reasons as discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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